

APPENDIX

In a different sense, and in a different manner, and upon different orders of the Court, petitioner has previously attempted to present to this Court the issue now under consideration. We refer to a motion by the petitioner here for leave to file a petition for Writ of Mandamus in the case of *BullDog Electric Products Co. v. The Honorable Clarence G. Galston, Judge*, No., October Term, 1943, which motion was denied by this Court on May 29, 1944.

Briefly, the relevant facts were these: Before filing its Reply to the Counterclaim of Westinghouse, BullDog filed a Motion to Dismiss the Counterclaim, based upon affidavits showing the purposes and effects of the Counterclaim, as being contrary to the public interest. The District Court, in denying that motion of BullDog to dismiss the counterclaim, indicated that the defense of unclean hands, though it might be available to an accused infringer, was not available "to serve the owner of a patent who threatened suit against a defendant whom he charges generally with unclean hands."

BullDog, thereupon, sought to have this Court issue a Mandamus directing Judge Galston to set aside his order of dismissal of that BullDog motion, and to consider that motion on the merits, contending then, as now, that the defense of unclean hands should be available to a patent owner equally as to an accused infringer, who is an aggressor seeking to maintain a monopoly by seeking to de-

stroy a competitor's patent. However, this Court denied BullDog's motion for leave to file the petition for Writ of Mandamus but did not indicate its reason. Whereas, Mandamus is an extraordinary remedy, Certiorari is the usual procedure involved for raising such questions as are raised in this Petition.

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Since the above petition was prepared for printing, the Hon. Grover M. Moscowitz, Judge of the United States District Court for the Eastern District of New York, at the same time that he handed down an opinion denying a motion by respondent, Westinghouse, for summary judgment in its favor on the counterclaim, which motion is based on patent questions, handed down an opinion denying a motion of the counter-defendant, BullDog, for leave to take depositions in opposition to the Westinghouse motion.

Such opinion further indicates the view of several district judges on the right of a patent owner to plead and prove questions of public interest and is but one of several opinions along the same lines rendered in this district in this suit.

A copy of the said opinion (not yet reported) is annexed hereto.

UNITED STATES DISTRICT COURT
Eastern District of New York

BullDog Electric Products Co., Plaintiff, —against— Cole Electric Products Co., Inc., and Westinghouse Electric & Manufacturing Company, Defendants.	}	Civil No. 2726. December 20, 1944.
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Moscowitz, D. J.

The plaintiff has made a motion herein for leave to take depositions in opposition to a motion made by one of the

defendants, Westinghouse Electric and Manufacturing Company, for summary judgment on its counterclaim.

The relief sought by the defendant is for summary judgment adjudicating plaintiff's patent No. 2,235,770 invalid.

Plaintiff's purpose in seeking the depositions is to establish that the defendant has "unclean hands." Both Judge Galston on February 28, 1944, and Judge Abruzzo on August 11, 1944, have decided in this same case that where the defendant, as here, is seeking to establish the invalidity of plaintiff's patent, plaintiff is not permitted to assert as a defense that the defendant is acting with "unclean hands." This is the law of the case and is therefore binding upon this court. See *Mutual Life Insurance Co. v. Hill*, 193 U. S. 551, 554.

It would be unseemly for a judge of coordinate jurisdiction to review the decisions of his associates even if such views were in conflict with his own and this court expresses no such view.

Judge Galston very aptly points out that:

"If the Westinghouse Company were seeking to enforce in this counterclaim one of its own patents, the doctrine of unclean hands might be available to a defendant; but the doctrine has not yet been extended to serve the owner of a patent who threatens suit against a defendant whom he charges generally with unclean hands. The motion is wholly without merit and must be denied."

A particular act or acts establishing "unclean hands" may be asserted as a defense only in an instance where the party guilty thereof seeks an adjudication of its right with respect to which the "unclean hands" occurred. See *Keystone Driller Co. v. General Excavator Co.*, 290 U. S. 240, 245. The doctrine of "unclean hands" may be asserted

against the owner of a patent seeking to assert its validity. That is not the case here. Even if the "unclean hands" doctrine were asserted against the defendant, it would avail the plaintiff naught.

The motion to take depositions is denied.

Settle order on notice.

Grover M. Moscovitz,
U. S. D. J.

